

AMENDMENT
U.S. Appln. No. 09/649,268

REMARKS

Claims 1-20 are pending in the application and stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

PRIOR UNENTERED AMENDMENT.

The Examiner is requested to enter this amendment in lieu of the after-final amendment submitted on December 31, 2003. While this amendment is similar to the previously submitted amendment in substance, this amendment fully complies with the revised amendment practice specified in 37 C.F.R. §1.121, effective July 30, 2003.

OBJECTIONS.

The Office Action objects to the specification indicating the original title was not sufficiently descriptive. By this amendment, Applicant amends the title to be more descriptive of the invention to which the claims are directed. Reconsideration is respectfully requested.

CLAIM REJECTIONS.

35 U.S.C. § 112 (second paragraph)

Claim 5 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite. By this amendment, Applicant amends claim 5 to address the Examiner's concerns. Reconsideration and withdrawal of this rejection is respectfully requested in light thereof.

35 U.S.C. § 102(b)

Claims 8-9, 13-14 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 5,748,084 to Isikoff. Applicant respectfully traverses this rejection in view of the amendments above and the remarks that follow.

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As is well-established, in order to successfully assert a *prima facie* case of anticipation, the Office Action must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. Therefore, if even one element or limitation is missing from the cited document, a *prima facie* case is not established.

It is respectfully asserted that, as one example, Isikoff fails to meet either expressly or inherently the limitation that a portable computing device has a modem that is able to store data that is used in the future by a user with a second processor while first processor is deactivated.

Isikoff makes clear that any activity involving data modem 20 also involves microprocessor 30. Thus, Isikoff cannot teach or suggest storing a communication with a modem when microprocessor 30 is inactive.

In particular, Isikoff states "[o]nce data begins to be received, the microprocessor temporarily stores the data in memory and alerts the host computer." (Column 5, lines 46-48). "This information is passed onto the microprocessor which determines what actions need to be taken within the beacon and what signals need to be sent the host computer." (Column 5, lines 29-32). "For an incoming voice call the microprocessor alerts the host computer via an interrupt or other hardware notification rout." (Column 5, lines 35-36). "Another type of incoming data is that of CDPD cellular packets. Such packets may contain e-mail, pages, etc. and might also contain low and high level control codes. These packets are examined by the microprocessor and passed on to the user interface software." (Column 6, lines 55-59, emphasis added).

Furthermore, the data stored by beacon 101 is not used by the user, but rather by the processor of the laptop. Isikoff states "The beacon ... communicates with the laptop computer or various subsystems thereof via a cryptographic exchange to effectively prevent unauthorized removal or bypassing of its security logic." (Column 4, lines 3-8).

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Accordingly, Applicant respectfully submits that Isikoff does not teach or suggest at least one feature of claim 8. Thus, claim 8, and the corresponding dependent claims, cannot be anticipated by Isikoff. In view of this fact, reconsideration and withdrawal of the §102(b) rejection is respectfully requested.

35 U.S.C. § 103(a)

1.) Claims 1-7, 10-12 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Isikoff. Applicant respectfully traverses this rejection for the following reasons.

It is well established that *prima facie* obviousness requires a teaching or a suggestion by the cited prior art of all the elements of a claim (M.P.E.P. §2142). Applicant respectfully submits that Isikoff does not teach or suggest a modem adapted to store at least a portion of a communication in the non-volatile memory when the processor is inactive and thus *prima facie* obviousness is not established.

In fact, since Isikoff makes clear that any activity involving data modem 20 also involves microprocessor 30, Isikoff teaches away from the claimed invention which stores a communication with a modem when microprocessor 30 is inactive. In addition, Isikoff fails to teach or suggest that beacon 101 is programmed by a user or that the data retrieved by beacon 101 is used by a user. Consequently, Isikoff does not render Applicant's claims 1-7, 10-12, or 16 obvious.

2.) Claims 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. 6,418,533 to Angelo et al. However, as admitted on page 6 of the Final Office Action, Angelo fails to teach or suggest at least one feature of Applicant's claim, namely a modem. Accordingly, since the prior art does not teach or suggest each element recited in Applicant's claims 18-20, Angelo cannot render this claims obvious.

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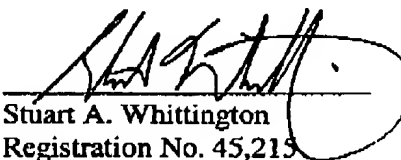
A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art [involves only routine skill, or was conventional] at the time the claimed invention was made" because the references relied upon teach all aspects of the claimed invention is not sufficient to establish a *prima facie* case of obviousness without some additional objective reason for modifying or combining the teachings of the references. *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding or evidence as to why the skilled artisan would have been motivated to make the claimed invention.) (i.e., the level of skill in the art cannot be relied upon to provide the suggestion to combine or modify references.)

For all the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of all §103(a) rejections of record.

CONCLUSION.

In view of the above, reconsideration and allowance of this application is now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to **Deposit Account # 50-0221.**

Respectfully submitted,



Stuart A. Whittington
Registration No. 45,215
Intel Corporation
(480) 554-2895

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c/o

Blakely, Sokoloff, Taylor & Zafman, LLP

12400 Wilshire Blvd., Seventh Floor

Los Angeles, CA. 90025-1026

(503) 264-0967

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